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AF/LEW/SH



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE: GASSMAN, Max P.)
) APPEAL NO. _____
SERIAL NO: 10/645,361)
)
FOR: LOW-SPEED HIGH-TORQUE)
CHIPPER-SHREDDER MACHINE)
) BRIEF ON APPEAL
FILED: August 21, 2003)
)
GROUP ART UNIT: 3725)

To the Commissioner of Patents and Trademarks
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INTRODUCTION

This is an appeal of the Final Rejection dated November 4, 2005 rejecting claims 1-6, 8-15, 17-23, 25 and 26. The appealed claims are in appealed form as set forth in an attached Appendix.

II. REAL PARTY IN INTEREST

The real party in interest is Iowa State University Research Foundation, Inc., as Assignee from the inventor. The Assignment was recorded on July 22, 2005 at reel 016297, frame 0600.

III. RELATED APPEALS AND INTERFERENCES

None.

IV. STATUS OF CLAIMS

Claims 1-6, 8-15, 17-22 and 25 are pending. All of these claims are appealed. Claims 7, 16 and 24 have been cancelled, and thus are not appealed.

V. STATUS OF AMENDMENTS

An amendment was filed on August 25, 2005 in response to the Office Action of July 28, 2005. No Amendments After Final were filed.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 and depending claims 2-6 and 8-10 are directed towards a chipper-shredder machine 10, as seen in Figures 1-3, which is used for yard waste. This machine 10 includes a motor 12 which drives a roller 16. See Specification, page 3, lines 2-7. Machine 10 also includes an inlet chute 26 to feed yard waste into the roller 16 which grinds the yard waste into mulch, and an outlet chute 28 to receive the mulch from the roller 16. See Specification, page 3, lines 11-15; Figure 1. The outlet chute 28 is spring loaded so as to prevent jamming or binding of the roller 16. More particularly, springs 30 are provided between the outlet chute 28 and a base plate 18 upon which the roller 16 is mounted. See Specification, page 3, lines 16-22; Figure 3.

Independent claim 11 is directed towards a yard material mulching machine 10 which has a feed chute with opposite inlet and outlet ends 26, 28 along which the yard material flows. A roller 16 is provided adjacent the feed chute. The outlet end 28 of the chute is spring loaded so as to reduce jams in the roller 16. A motor 12 rotates the roller 16 so that the yard material is crushed between the roller 16 and the feed chute, thereby reducing the yard material into mulch. See Specification, page 3, lines 1-22; Figures 1-3.

Independent claim 18 is directed towards a method of reducing yard waste material into mulch. The method includes the step of feeding the yard waste material into an inlet chute 26, and then crushing and grinding the yard waste material with a rotating roller 16. The method also includes the step of discharging the crushed yard waste material onto a

spring loaded outlet chute 28 that receives of the crushed yard waste material from the rotating roller 16, with the outlet chute 28 being biased toward the roller 16 in order to inhibit jams in the roller 16. See Specification, page 4, lines 3-13; Figures 1-3.

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-5, 8-14, 17-22 and 25 have been rejected under 35 U.S.C. § 103 as being obvious over Karg, Patent No. 5,226,607, in view of Fickett, Patent No. 2,130,457. Claims 6, 15, 23 and 26 have been rejected under 35 U.S.C. § 103 as being obvious over Karg, Fickett and Hinsey, Patent No. 5,052,630.

VIII. ARGUMENT

Both of independent apparatus claims 1 and 11 require a spring-loaded outlet chute on the yard waste machine. Similarly, independent method claim 18 requires the step of discharging the yard waste material onto a spring-loaded outlet chute. This spring-loaded outlet chute requirement of independent claims 1, 11 and 18 distinguishes these claims over the cited references. Accordingly, Applicant believes that all of the pending claims are allowable.

The Examiner has failed to make out a *prima facie* case of obviousness based upon the combination of Karg and Fickett. The Examiner's failure to follow the legal guidelines or standards for an obviousness rejection requires that the § 103 rejections of all the claims be reversed.

As seen in Figure 1 of Karg, the outlet or ejection chute 5 is spaced below the roller 3 which crushes the yard waste material introduced through the inlet chute 4. Karg does not have a biased outlet chute. The Examiner cites the Fickett patent as teaching a spring biased chute 21. However, the chute 21 of Fickett is part of the inlet chute on the upstream side of the cutting disk 15. There is no spring biased outlet chute in Fickett. Thus, neither reference cited by the Examiner has a spring-loaded outlet chute, as required by all of the claims.

Furthermore, as the Federal Circuit has explained, "Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. . . . The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (*emphasis added*). In re Fritch, 972 F.2d 1260, 1266 (Fed Cir. 1992). More particularly, the Federal Circuit has stated that for a § 103 obviousness rejection based upon a combination of patents, there must be "some objective teaching" leading to the combination. Fritch, 972 F.2d at 1265. As further explained by the Federal Circuit in In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999), this showing must be "clear and particular."

The Examiner has provided no clear and particular teaching in Karg or Fickett regarding an outlet chute which is spring biased or spring-loaded. The Examiner also fails to provide any alleged motivating force for combining Karg and Fickett. The Examiner states that a use of a spring biased chute allows for yielding of a chute wall. However, this definitional statement that a spring biased chute provides a yielding chute wall is not a motivational basis for combining the references. There is no mention in Fickett of jams or

clogs. In the absence of such an objective teaching, there is no motivation for combining Karg and Fickett. Even if Kang and Fickett are combined, at best the combination produces a yard waste mulching machine with a spring-loaded inlet chute, but not a spring-loaded outlet chute, as required by the claims.

Also, as further stated by the Federal Circuit, "an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would compel one skilled in the art do what the patent applicant has done." Ex parte Levengood, 28 U.S.P.Q.2d 1300, 1302 (Fed. Cir. 1993). Even if it is assumed that there is a motivating force of preventing jams in the machine, the Examiner has provided no evidence to support such a motivating force, particularly since Fickett has no mention of jams in its machine.

As the Board of Patent Appeals and Interferences has stated, citing references which merely indicate that isolated elements and/or features recited in claims are known is not sufficient basis for concluding that the combination of claimed elements would have been obvious." Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (B.P.A.I. 1988).

In short, as stated by the Federal Circuit,

"It is wrong to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims-in-suit." Orthopedic Equipment Company v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

The Examiner's unsupported conclusion that a spring-loaded inlet chute, as shown in Fickett, makes it obvious to provide a spring-loaded outlet chute on Karg is insufficient to

support an obviousness rejection. The Examiner is ignoring the term "outlet" in each of the independent claims 1, 11 and 18. However, well-known claim construction principles make it improper to read out any claim limitation.

Since the references relied upon by the Examiner in the rejection of the claims have no teaching or suggestion of a spring-loaded outlet chute, and the Examiner has provided no motivation for combining the references, or to change a spring-loaded inlet chute to a spring-loaded outlet chute, the obviousness rejections of the claims must be reversed.

IX. CONCLUSION

For the above-stated reasons, it is submitted that the claims are in a condition for allowability. The decision of the Examiner, therefore, should be reversed and the case allowed.

Enclosed is a check for \$250.00 for this Appeal Brief. If this amount is not correct, please consider this a request to debit or credit Deposit Account No. 26-0084 accordingly.

Respectfully submitted,



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X. APPENDIX - CLAIMS

Claim 1 (Previously presented): A chipper-shredder machine for yard waste, comprising:
a motor;
a roller operatively driven by the motor;
an inlet chute to feed yard waste to the roller so as to grind the yard waste into mulch; and
an outlet chute to receive the mulch from the roller, the outlet chute being spring loaded.

Claim 2 (Original): The machine of claim 1 wherein the roller includes a plurality of teeth to feed the waste through the roller.

Claim 3 (Original): The machine of claim 1 wherein the roller has a torque of at least 2000 lb-in.

Claim 4 (Original): The machine of claim 3 wherein the roller operates at a speed of approximately 60 rpm.

Claim 5 (Original): The machine of claim 1 further comprising a speed reducer between the motor and the roller.

Claim 6 (Original): The motor of claim 1 wherein the motor is reversible.

Claim 7 (Cancelled).

Claim 8 (Original): The machine of claim 1 wherein the motor is electric.

Claim 9 (Original): The machine of claim 8 wherein the motor has an output power of approximately 1 to 2 horsepower.

Claim 10 (Original): The machine of claim 1 wherein the roller has two sets of differently shaped teeth to enhance grinding of the yard waste.

Claim 11 (Previously presented): A yard material mulching machine comprising:
a feed chute with opposite inlet and outlet ends, and along which the yard material flows;
the outlet end being spring loaded so as to reduce jams in the roller;
a roller adjacent the feed chute; and
a motor for rotating the roller such that the yard material is crushed between the roller and the feed chute and thereby reduced into mulch.

Claim 12 (Previously presented): The machine of claim 11 wherein the roller has a torque of at least 2000 lb-in.

Claim 13 (Original): The machine of claim 12 wherein the roller operates at a speed of approximately 60 rpm.

Claim 14 (Original): The machine of claim 11 further comprising a speed reducer between the motor and the roller.

Claim 15 (Original): The machine of claim 11 wherein the motor is reversible.

Claim 16 (Cancelled)

Claim 17 (Original): The machine of claim 11 wherein the motor is electrically powered.

Claim 18 (Previously presented): A method of reducing yard waste material into mulch, comprising:
feeding the yard waste material into an inlet chute;
crushing and grinding the yard waste material with a rotating roller; and
discharging the crushed yard waste material onto a spring loaded outlet chute that receives the crushed yard waste material from the rotating roller and that is biased toward the roller in order to inhibit jams in the roller.

Claim 19 (Original): The method of claim 18 wherein the roller is operated at low speed and high torque.

Claim 20 (Original): The method of claim 19 wherein the roller rotates at approximately 60 rpm.

Claim 21 (Original): The method of claim 19 wherein the roller has a torque of at least 2000 lb-in.

Claim 22 (Original): The method of claim 18 wherein the material is reduced to mulch without using cutting or impact blades.

Claim 23 (Original): The method of claim 18 further comprising rotating the roller in a first direction for mulching and rotating the roller in an opposite direction for unclogging a jam.

Claim 24 (Cancelled)

Claim 25 (Original): The method of claim 18 further comprising rotating the roller with an electric motor.

Claim 26 (Original): The method of claim 18 further comprising rotating the roller in opposite directions with a reversible motor.

XI. EVIDENCE APPENDIX

None

XII. RELATED PROCEEDING APPENDIX

None